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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/897,755      | 07/03/2001  | Peng Cho Tang        | 038602-1220         | 1137             |

7590 11/18/2002

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EXAMINER

WRIGHT, SONYA N

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1626

DATE MAILED: 11/18/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/897,755

Applicant(s)

TANG ET AL.

Examiner

Sonya Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

### **DETAILED ACTION**

This is a response to Applicant's remarks filed 9-13-02. Claims 8-11 are pending in this application.

The objection to claims 8-11 for containing non-elected subject matter has been maintained for the reasons of record. The obviousness-type double patenting rejections have been maintained for the reasons of record.

Claim 1 was rejected under 35 U.S.C. 112. Applicant is correct in pointing out that the 112 rejection should have been made over claim 8. The 112 rejection has been overcome with Applicant's amendment.

### ***Response to Arguments***

Applicant's arguments filed 9-13-02 have been fully considered but they are not persuasive. Applicant argues that MPEP § 803.2 prescribes that "[f]ollowing election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability." However, the instant claims are drawn to a plethora of patentably distinct species which are variously classified. Not to restrict the invention would create an undue burden on the examiner. Therefore, the restriction requirement has been maintained.

Applicant argues that none of the cited patents contemplate or suggest indolinones wherein one or more atoms on the indolinone ring are nitrogen and that the genus claimed in claim 8 is not prima facie obvious in light of the teachings of U.S. Patent Nos. 6,313,158; 5,792,783; 6,395,734 and co-pending application 09/769,198. However, '158 gives preferred structural features which would direct one of ordinary skill

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in the art to prepare the instant compounds. See column 8, lines 58-66, and column 9, lines 1-5. In '158 preferred structural features are: R1 is hydrogen and alkyl, corresponding to R1 in the instant claims which is hydrogen or alkyl; Z is sulfur or oxygen, corresponding to R2 in the instant claims, which is oxygen or sulfur; R2 is hydrogen, corresponding to R3 in the instant claims which is hydrogen; A is nitrogen, which teaches the pyrrole group for "A" in the instant claims; R3 is hydrogen and alkyl, which teaches an alkyl substituent on the pyrrole "A" in the instant claims, and which teaches an unsubstituted pyrrole "A" in the instant claims; R4 and R5 are hydrogen, alkyl, aryl, cyano, corresponding to the substituents hydrogen, alkyl, aryl, and cyano on the pyrrole "A", or which teaches an unsubstituted pyrrole "A" in the instant claims. Furthermore, in '158, claim 1 contains an indolinone group in the core structure, as in the instant claims.

U.S. Patent '783 gives a preferred embodiment, 3-(2,4-dimethylpyrrol-5-yl)methylene-2-indolinone, which would direct one of ordinary skill in the art to prepare the instant compounds. See column 11, lines 7-8. The preferred embodiment directs one to define A in the instant claims as pyrrole substituted by alkyl groups, and the preferred embodiment directs one to define R1, and R3-R7 as hydrogen. Furthermore, in '783, the core structure of claim 1 contains an indolinone group, as in the instant claims.

U.S. Patent '734 gives preferred structural features which would direct one of ordinary skill in the art to prepare the instant compounds. See column 9, lines 43-67 and column 10, lines 1-38. In '734, preferred structural features are when R1 is

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hydrogen, corresponding to R1 of the instant claims which is hydrogen or alkyl; R2 is hydrogen, corresponding to R3 in the instant claims which is hydrogen; R7 is hydrogen, corresponding to a hydrogen substituent on an unsubstituted pyrrole ring (variable A) of the instant claims; R3, R4, R5, and R6 are defined to be various moieties which correspond to variables R4, R5, R6, and R7 of the instant claims. In '734, R8, R9, and R10 are defined to be various moieties which correspond to variables on the pyrrole ring (variable A) in the instant claims. Furthermore, in '734, the core structure of claim 1 contains an indolinone group, as in the instant claims.

U.S. Patent Application 09/762198 gives preferred aspects of the invention which would direct one of ordinary skill in the art to prepare the instant compounds. In '198, see page 25, lines 15-19, wherein Q is pyrrole, which corresponds to "A" of the instant claims which can be pyrrole. In '198 preferred aspects when Q is pyrrole, R1 is hydrogen and lower alkyl,  $-(CH_2)_nCO_2OH$  (wherein  $n=2$  or  $3$ ), which corresponds to the instant claims wherein R4 is hydrogen, alkyl,  $-(CH_2)_nCO_2OH$  (wherein  $n=2$  or  $3$ ); R2 is hydrogen, halo, loweralkyl, lower alkoxy,  $-SO_2NR_{21}R_{22}$  (wherein R21 and R22 are hydrogen, alkyl, and aryl) and  $-C(O)OH$  which corresponds to the instant claims wherein R5 is hydrogen, alkyl, alkoxy,  $SO_2NRR'$  (wherein R and R' are hydrogen, alkyl, or aryl), halogen,  $-(CH_2)_nCO_2R$  (wherein n is 0 and R is H); R3 is hydrogen, halo, lower alkyl, lower alkoxy, and aryl optionally substituted with one or more lower alkoxy groups, which corresponds to R6 in the instant claims which is defined as hydrogen, halogen, alkyl, alkoxy, and aryl; and R4 is hydrogen, which corresponds to R7 in the instant

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claims which is hydrogen. Furthermore, in claim 1, the core structure contains an indolinone group, as in the instant claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Friday from 8:00 AM - 5:30 PM.

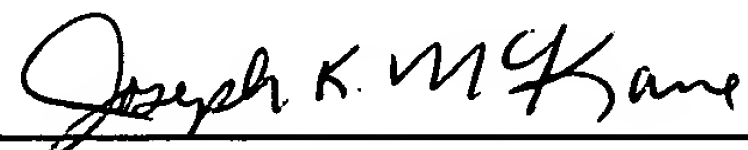
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for

draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.



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Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

November 6, 2002